

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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JEFFREY SCHWINDT, MICHAEL E. MILLER, JOSEPH L. MARK,  
JOHN P. HANCOCK and CHARLES BUTCHER

Junior Party  
(Application No. 10/936,395),  
v.

MICHAEL E. MILLER, JOSEPH L. MARK,  
JOHN P. HANCOCK and CHARLES BUTCHER

Senior Party  
(Patent No. 6,758,824).

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Patent Interference No. 105,805 (SCM)  
(Technology Center 3700)

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**DECLARATION – Bd. R. 203(b)<sup>1</sup>**

**Part A. Declaration of Interference**

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application, patent, count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this DECLARATION.

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<sup>1</sup> “Bd. R. x” may be used as shorthand for “37 C.F.R. § 41.x”. 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

1           **Part B. Judge managing the interference**

2           Administrative Patent Judge Sally C. Medley has been designated to manage  
3 the interference. Bd. R. 104(a).

4           **Part C. Standing order**

5           A Trial Section STANDING ORDER [SO] (Paper 2) accompanies this  
6 DECLARATION. The STANDING ORDER applies to this interference. The  
7 STANDING ORDER has recently been updated. An Executive Summary of  
8 significant changes is provided.

9           **Part D. Initial conference call**

10          A telephone conference call to discuss the interference is set for **1:30 p.m.**  
11 **on 12 July 2011** (the Board will initiate the call). The interference is declared to  
12 resolve an apparent inventorship dispute. *Chou v. University of Chicago*, 254, F.3d  
13 1347, 1358 n.2 (Fed. Cir. 2001) (one means for a putative inventor to assert  
14 inventorship rights is to file a patent application and have the PTO declare an  
15 interference to establish inventorship). The parties should be prepared to discuss,  
16 during the conference call, why any issues other than inventorship should be  
17 considered.

18          No later than **four business days** prior to the conference call, each party  
19 shall file and serve (SO ¶¶ 10.1 & 105) a list of the motions (Bd.R. 120; Bd.R. 204;  
20 SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

21          A sample schedule for taking action during the motion phase appears as  
22 Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the  
23 schedule prior to the conference call and to agree on dates for taking action. A  
24 typical motion period lasts approximately eight (8) months. Counsel should be  
25 prepared to justify any request for a shorter or longer period.

**Part E. Identification and order of the parties**

Junior Party

Named Inventors: JEFFREY SCHWINDT, Indianapolis, IN  
MICHAEL E. MILLER, Trafalgar, IN  
JOSEPH L. MARK, Indianapolis, IN  
JOHN P. HANCOCK, Fishers, IN  
CHARLES BUTCHER, Carmel, IN

Involved Application: Application 10/936,395, filed 8 September 2004

Title: Biopsy apparatus

Assignee: Tissue Extraction Devices, LLC

Senior Party

Named Inventors: MICHAEL E. MILLER, Trafalgar, IN  
JOSEPH L. MARK, Indianapolis, IN  
JOHN P. HANCOCK, Fishers, IN  
CHARLES BUTCHER, Carmel, IN

Involved Patent: Patent No. 6,758,824 issued 6 July 2004, based on  
Application 09/707,022, filed 6 November 2000

Title: Biopsy apparatus

Assignee: Suros Surgical Systems, Inc.

The senior party is assigned exhibit numbers 1001-1999. The junior party is assigned exhibit numbers 2001-2999. Bd.R. 154(c)(1); SO ¶ 154.2.1. The senior party is responsible for initiating settlement discussions. SO ¶ 126.1.

**Part F. Count and claims of the parties**

Count 1

Claim 1 of Schwindt's Application or Claim 1 of Miller's Patent

Count 2

Claim 2 of Schwindt's Application or Claim 2 of Miller's Patent

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| 1  | <u>Count 3</u>  |
| 2  | Claim 3 of Schwindt's Application or Claim 3 of Miller's Patent   |
| 3  | <u>Count 4</u>  |
| 4  | Claim 4 of Schwindt's Application or Claim 4 of Miller's Patent   |
| 5  | <u>Count 5</u>  |
| 6  | Claim 5 of Schwindt's Application or Claim 5 of Miller's Patent   |
| 7  | <u>Count 6</u>  |
| 8  | Claim 6 of Schwindt's Application or Claim 6 of Miller's Patent   |
| 9  | <u>Count 7</u>  |
| 10 | Claim 7 of Schwindt's Application or Claim 7 of Miller's Patent   |
| 11 | <u>Count 8</u>  |
| 12 | Claim 8 of Schwindt's Application or Claim 8 of Miller's Patent   |
| 13 | <u>Count 9</u>  |
| 14 | Claim 9 of Schwindt's Application or Claim 9 of Miller's Patent   |
| 15 | <u>Count 10</u>   |
| 16 | Claim 10 of Schwindt's Application or Claim 10 of Miller's Patent |
| 17 | <u>Count 11</u>   |
| 18 | Claim 11 of Schwindt's Application or Claim 11 of Miller's Patent |
| 19 | <u>Count 12</u>   |
| 20 | Claim 12 of Schwindt's Application or Claim 12 of Miller's Patent |
| 21 | <u>Count 13</u>   |
| 22 | Claim 13 of Schwindt's Application or Claim 13 of Miller's Patent |
| 23 | <u>Count 14</u>   |
| 24 | Claim 14 of Schwindt's Application or Claim 14 of Miller's Patent |
| 25 | <u>Count 15</u>   |
| 26 | Claim 15 of Schwindt's Application or Claim 15 of Miller's Patent |
| 27 | <u>Count 16</u>   |



Count 30

### Claim 30 of Schwindt's Application or Claim 30 of Miller's Patent

Count 31

### Claim 31 of Schwindt's Application or Claim 31 of Miller's Patent

Count 32

### Claim 32 of Schwindt's Application or Claim 32 of Miller's Patent

Count 33

### Claim 33 of Schwindt's Application or Claim 33 of Miller's Patent

Count 34

### Claim 34 of Schwindt's Application or Claim 34 of Miller's Patent

Count 35

### Claim 35 of Schwindt's Application or Claim 35 of Miller's Patent

Count 36

### Claim 36 of Schwindt's Application or Claim 36 of Miller's Patent

Count 37

### Claim 37 of Schwindt's Application or Claim 37 of Miller's Patent

The claims of the parties are:

Schwindt: 1-37

Miller: 1-37

The claim of the party that is found in each count is that party's claim that corresponds to that particular count. For example, claim 1 of the involved application and claim 1 of the involved patent corresponds to Count 1, claim 2 of the involved application and claim 2 of the involved patent corresponds to Count 2, claim 3 of the involved application and claim 3 of the involved patent corresponds to Count 3, and so forth.

1       The claims of the parties which do not correspond to Counts 1-37 are:

2               Schwindt:   none

3               Miller:       none

4       The parties are accorded the following benefit for Counts 1-37:

5               Schwindt:   none

6               Miller:       none

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The following heading must be used on all papers filed in this interference,  
see SO ¶ 106.1.1:

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## Junior Party

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## Part H. Order form for requesting file copies

When requesting copies of files, use of SO Form 4 will greatly expedite processing of the request. Please attach a copy of Parts E and F of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

/Sally C. Medley/  
Administrative Patent Judge



1 Enc:

2 Copy of STANDING ORDER (March 2011)  
3 Copy of Executive Summary of STANDING ORDER  
4 Copy of claims of Application 10/936,395  
5 Copy of Patent 6,758,824  
6 Copy of Form PTO-850

7

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9 cc (via overnight delivery):

10 Attorney for Schwindt:

11 IP Advisors  
12 Christopher Haigh  
13 150 N. Michigan Ave.  
14 STE. 2800  
15 CHICAGO IL 60601

16

17 Attorney for Miller:

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19 RADER, FISHMAN & GRAUER PLLC  
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21 BLOOMFIELD HILLS, MI 48304